



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/038,158	03/11/98	WALLMAN	S 10392-46001
------------	----------	---------	---------------

023838 TM02/0131  
KENYON & KENYON  
1500 K STREET, N.W., SUITE 700  
WASHINGTON DC 20005

EXAMINER

CALVE, J

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

01/31/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/038,158

Applicant(s)

WALLMAN, Steven M. H.

Examiner

Jim Calve

Group Art Unit

2164

☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-49 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-49 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Mar 11, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3721

### DETAILED ACTION

1. The finality of the rejection contained in the previous office action (Paper #10) has been withdrawn in order to apply new grounds of rejection. *See* MPEP 706.07(e).

#### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the arrow on a dial (claim 33) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

#### *Claim Rejections - 35 USC § 102*

3. Claims 1, 4-8, 44, 45, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris et al, U.S. patent 5,918,218.

Harris et al disclose a trading system and method for enabling a plurality of users to create, manage, and trade a portfolio of assets/liabilities with a processor (40, 50), communicating with a plurality of users (e.g., column 2, line 30 et seq; column 6, line 10 et seq), aggregation of buy/sell orders (e.g., column 6, line 30 et seq; column 7, line 1 et seq), storage (40), and electronic payment system (e.g., 1758) (Figure 17C).

Harris et al also disclose an electronic payment system (e.g., 1758) (Figure 17C), plural accounts and payment storage (e.g., Figures 17A-D; column 2, line 60 et seq; column 13, line 38 et seq), communication link (e.g., 240), sending aggregate users' trades to third party trader (e.g., column 7, line 10 et seq).

Art Unit: 3721

4. Claims 30, 32, 44, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Ray, U.S. patent 6,018,722.

Ray et al disclose a PC-based program to create, manage, and trade a portfolio of assets/liabilities with a GUI (e.g., 200, 210, 230) (Figure 2; column 10, line 25 et seq), asset allocation model (115), user preference data (Figure 6), plurality of assets/liabilities for portfolio (e.g., column 5, line 25 et seq), risk and return calculation process (e.g., 720) (e.g., column 5, line 20 et seq), portfolio editor (Figure 7), and communication process (130, 450) (Figures 1, 4; column 9, line 23 et seq), processor receiving user data/amounts of money to be invested (e.g., column 9, line 22 et seq; column 10, line 1 et seq), and storage unit (245).

Ray et al also disclose a numerical indicator (e.g., column 5, line 20 et seq).

***Claim Rejections - 35 USC § 103***

5. Claims 2, 3, 9-17, 19-25, 36-42, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al, in view of Jones et al, U.S. patent 6,021,397 (and Maggioncalda et al, U.S. patent 5,918,217, which is incorporated therein by reference; column 12, line 35 et seq).

Harris et al disclose a trading system and method, as discussed, including periodically aggregating and executing transactions over an amount of transactions (e.g., column 6, line 50 et seq; column 7, line 10 et seq), a processor, communication of user ID (e.g., Figures 11-14), periodic/monthly payments (e.g., payroll deductions, column 8, line 15 et seq), fractional shares (e.g., column 8, line 25 et seq), trade pricing information (column 7, line 27 et seq), and payment information (e.g., column 6, line 23 et seq). Harris et al do not disclose asset allocation/portfolio

Art Unit: 3721

creation based on user preferences. Jones et al disclose a user trader system with asset allocation modeling to select assets (e.g., column 2, line 15 et seq; column 2, line 50 et seq; column 3, line 40 et seq), user PC (345) for user ID and preferences (e.g., Figures 1, 3; column 5, line 50 et seq), GUI risk and return process (Maggioncalda et al, Figures 4-7c, 9, 10, 12a/b, 14a/b), allocation adjustment (Maggioncalda et al, Figures 12a, 12b), program transmission (e.g., column 5, line 40 et seq), tax basis (320) (column 10, line 25 et seq), pricing data reallocation (column 12, line 10 et seq; column 18, line 50 et seq; column 19, line 17 et seq), Internet/WWW site (column 7, line 55 et seq; column 5, line 40 et seq). An asset allocation modeling process provides an improved means to assist an individual in creating an attainable portfolio (e.g., column 4, line 5 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an asset allocation and portfolio modeling process, as taught by Jones et al, on the method and system of Harris et al to provide an improved means for an individual to manage a portfolio (e.g., for retirement). Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to aggregate transactions more frequently (e.g., a plurality of predetermined times) in order to reduce the size of the omnibus trade file transactions to facilitate execution (cf., Harris et al, column 7, line 50 et seq).

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al, in view of Jones et al (and Maggioncalda et al) as applied to claim 10 above, and further in view of Debe et al, U.S. patent 5,758,097.

Art Unit: 3721

The modified system of Harris et al discloses a trading system. The modified system of Harris et al does not disclose user voting rights information. Debe et al disclose a trading system for tracking user voting rights (Figure 2; column 5, line 42 et seq). A vote tracking system provides an improved means of tracking users' voting interests in investment assets (e.g., those involving fractional interests in an asset) (column 2, line 33 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a vote tracking system, as taught by Debe et al, on the modified system of Harris et al to provide a means of tracking users' voting rights in various investment assets.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al, in view of Jones et al (and Maggioncalda et al, U.S. patent 5,918,217, which is incorporated therein by reference; column 12, line 35 et seq) as applied to claim 25 above, and further in view of Champion et al, U.S. patent 5,126,936.

The modified system of Harris et al discloses a trading system, as discussed. The modified system of Harris et al does not disclose a direct dial-up telephone. Champion et al disclose a trading system with direct dial-up telephone connection (Figure 2). A direct-dial telephone connection provides a well-known communication means for a trading system (e.g., column 5, line 25 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a direct-dial connection, as taught by Champion et al, on the modified system of Harris et al to provide an efficient, inexpensive means for a user to communicate with the system.

Art Unit: 3721

8. Claims 27-29 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al, in view of Champion et al, U.S. patent 5,126,936.

Harris et al disclose a trading system, as discussed, including order aggregation. Harris et al do not disclose a direct dial-up telephone or netting orders. Champion et al disclose a trading system with direct/intermediate dial-up telephone connection (Figure 2) and aggregating and netting orders (e.g., column 5, line 10 et seq). A direct-dial telephone connection provides a well-known communication means for a trading system (e.g., column 5, line 25 et seq), while order aggregation and netting provides an improved means to significantly reduce transaction expenses (e.g., column 5, line 50 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a direct-dial connection and order aggregation and netting, as taught by Champion et al, on the system of Harris et al to provide an efficient, inexpensive means for a user to communicate with the system and for orders to be transacted.

9. Claims 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al, U.S. patent 6,021,397 (and Maggioncalda et al, U.S. patent 5,918,217, which is incorporated therein by reference; column 12, line 35 et seq), in view of Ray et al, U.S. patent 6,018,722.

Jones et al disclose a personal computer program for creating, managing, and trading a portfolio of assets/liabilities, including a GUI (345) for user identification and preference data (e.g., column 5, line 50 et seq), a user preference asset allocation modeling process (e.g., column 2, line 15 et seq; column 2, line 50 et seq; column 3, line 40 et seq) risk and return process (e.g., column 8, line 50 et seq), portfolio editor (e.g., Figure 8; column 6, line 40 et seq),

Art Unit: 3721

communication process (e.g., column 6, line 30 et seq; also Maggioncalda et al, Figure 4). To the extent that Jones et al could be interpreted not to disclose a communication process to execute trades, Ray et al disclose a personal computer program for creating, managing, and trading a portfolio of assets/liabilities, including GUI (e.g., 200, 210, 230) (Figure 2; column 10, line 25 et seq), asset allocation model (115), user preference data (Figure 6), plurality of assets/liabilities for portfolio (e.g., column 5, line 25 et seq), risk and return calculation process (e.g., 720) (e.g., column 5, line 20 et seq), portfolio editor (Figure 7), and communication process (130, 450) (Figures 1, 4; column 9, line 23 et seq), processor receiving user data/amounts of money to be invested (e.g., column 9, line 22 et seq; column 10, line 1 et seq), and storage unit (245). A communication process provides a means to implement recommendations generated by an asset allocation/portfolio optimization process program, thereby enabling an individual to manage an investment portfolio (e.g., Ray et al; column 2, line 10 et seq; Jones et al, column 6, line 30 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a communication process, as taught by Ray et al, on the device of Jones et al to provide a means to implement a selected portfolio.

Jones et al also disclose a GUI display of risk and return, numerical indicator, (e.g., Figures 4-7c, 9, 10), "arrow on a dial"/range of numerical values (e.g., Figures 5b, 6, 9, 12a/b, 14a/b). Further, Ray et al also disclose a numerical indicator (e.g., column 5, line 20 et seq). Jones et al are deemed to disclose an "arrow" on a dial/range of numerical values, as disclosed in the present application (page 41, lines 7-9). To the extent that Jones et al do not



Art Unit: 3721

disclose color codes, Official Notice is taken that the concept and advantages of color codes in providing an enhanced visual depiction of investment returns and risks are well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide color codes for investment risks and returns to enable a user to better comprehend those relative risks and returns (cf., Maggioncalda et al, column 13, line 10 et seq). Official Notice is also taken that the concept and advantages of control processes that automatically update versions of a user program are well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide system updates of a user program in order to automatically provide the most recent features of a user program.

10. Claims 43 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al, in view of Jones et al, U.S. patent 6,021,397 (and Maggioncalda et al, U.S. patent 5,918,217, which is incorporated therein by reference; column 12, line 35 et seq), as applied to claims 42 and 48 above, and further in view of Champion, U.S. patent 5,126,936.

The modified method of Harris et al discloses a periodic investment method, as discussed, including order aggregation. The modified method of Harris et al does not disclose netting orders. Champion et al disclose a trading method including aggregating and netting orders (e.g., column 5, line 10 et seq). Order aggregation and netting provides an improved means to significantly reduce transaction expenses (e.g., column 5, line 50 et seq. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide order aggregation

Art Unit: 3721

and netting, as taught by Champion et al, on the method of Harris et al to provide an efficient, inexpensive means for a user to communicate with the system and for orders to be transacted.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-49 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim Calve, whose telephone number is (703) 308-1884. The examiner can normally be reached on Tuesday through Friday from 6:45 am to 6:45 pm. If the examiner is unavailable, the examiner's supervisor, Vincent Millin, may be reached at (703) 308-1065. The fax number for this organization is (703) 305-9051/9052. Any inquiry of a general nature should be directed to the receptionist at (703) 305-3900.

JPC  
JPC

January 19, 2001

  
VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100